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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,972	01/16/2004	James Stoffer	423.027US1	6512

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EXAMINER
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ART UNIT	PAPER NUMBER
1714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,972

Applicant(s)

STOFFER ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 23-29, 154-159, 162 and 163 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/19/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-8, 10-31, 35, 39-59, 61, 62, 67-70, 121, 122, 132, 133, 139, 141, 143-145, 147-151, 154-168, 184, 186, 187 and 191.

Continuation of Disposition of Claims: Claims rejected are 1-8, 10-22, 30, 31, 35, 39-59, 61, 62, 67-70, 121, 122, 132, 133, 139, 141, 143-145, 147-151, 160, 161, 164-168, 184, 186, 187 and 191.

DETAILED ACTION

1. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 4/19/2007.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 7/17/2007. In particular, claims 35, 70, and 121 have been amended to include an extender that is calcium sulfate and/or strontium sulfate. Thus, the following action is properly made final.

Claim Objections

4. Claims 1, 7, 13, 14, 40, 41, 56, 67, 141, and 164 objected to because of the following reasons:

With respect to claim 1, the phrase "wherein the praseodymium oxide comprises about 1 wt% to about 90 wt% of the solid components" is incorrect because it is the solid components which comprises the praseodymium oxide. It is suggested that the cited language be replaced with the following: --wherein the solid components comprises about 1 wt% to about 90wt% of the praseodymium oxide--.

With respect to claims 13, 14, 40, 41, 56, 67, 141, and 164, they are objected to for the same reasons as claim 1 above.

With respect to claim 7, the term "compounds" in line 3 should be replaced with --oxides--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. Claims 1, 7, 10, 11, 13, 14, 17, 19, 56-58, 141, 143-145, and 164-166 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al (JP 05-117589).

The rejection is adequately set forth in paragraph 9 of Office action mailed 10/19/2006 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

6. Claims 2, 3, 67, 68, and 150 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi et al (JP 05-117589, machine translation).

The rejection is adequately set forth in paragraph 10 of Office action mailed 10/19/2006 and is incorporated here by reference.

7. Claims 1-8, 10-20, 30, 31, 56-59, 61, 62, 67-69, 139, 141, 143-145, 147-150, 164-168, and 184 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780, cited on IDS dated 8/23/2004).

The rejection is adequately set forth in paragraph 11 of Office action mailed 10/19/2006 and is incorporated here by reference.

8. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780, cited on IDS dated 8/23/2004) in view of Oakes (US 4,370,256).

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The rejection is adequately set forth in paragraph 12 of Office action mailed 10/19/2006 and is incorporated here by reference.

9. Claims 35, 39-52, 54, 55, 70, 121, 122, 132, 133, 151, 160, 161, 186, and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780, cited on IDS dated 8/23/2004) in view of Reuter et al (US 2003/0082368).

The discussion with respect to Shoji et al in paragraph 8 above is incorporated here by reference.

Shoji et al does not disclose the use of calcium sulfate but teaches the use of additional compounds that reinforce the corrosion-resistance (col. 11, lines 4-19).

Reuter et al discloses an aqueous coating material and teaches that typical anticorrosion pigments include calcium sulfate (paragraph 0069). Although both Shoji et al and Reuter et al are explicitly silent with respect to appropriate amounts of anticorrosion pigments, Shoji et al suggests parameters for determining the amount of additives (col. 9, lines 61-64).

Given that Shoji et al is open to the use of other anticorrosive or rustproof pigments and given the teaching by Reuter et al regarding that calcium sulfate is a typical and well known anticorrosion pigment, it would have been obvious to one of ordinary skill in the art to utilize a calcium sulfate as the anticorrosive pigment in amounts as suggested by Shoji et al.

10. Claims 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780, cited on IDS dated 8/23/2004) in view of Reuter et al (US 2003/0082368) and further in view of Tucker (US 3,837,894).

The discussion with respect to Shoji et al and Reuter et al in paragraph 9 above is incorporated here by reference.

Shoji et al does not disclose the use of an inorganic binder such as that based on a silicone resin but appears to be open to other suitable resins (col. 13, lines 23-32).

Tucker discloses a corrosion resistant coating and teaches that epoxy resins (which are taught by Shoji et al) and silicone resins are advantageously used because they are highly resistant to many aqueous corrosive environments (col. 1, lines 31-34).

Given that Shoji et al is open to the use of other resins not disclosed and further given that silicone resins are advantageously used like epoxy resins, it would have been obvious to one of ordinary skill in the art to utilize a silicone resin in the composition of Shoji et al.

11. Claims 191 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al (US 6,190,780, cited on IDS dated 8/23/2004) in view of Reuter et al (US 2003/0082368) and further in view of Koefod (US 5,531,931).

The discussion with respect to Shoji et al and Reuter et al in paragraph 9 above is incorporated here by reference.

Shoji et al does not disclose the use of calcium sulfate but teaches the use of additional compounds that reinforce the corrosion-resistance (col. 11, lines 4-19).

Koefod teaches that rare earths salts such as praseodymium sulfate are used as corrosion inhibitors (col. 4, lines 8-28).

Given that Shoji et al is open to the use of other anticorrosive or rustproof pigments and given the teaching by Koefod regarding praseodymium sulfate that it is a typical and well known

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anticorrosion additive, it would have been obvious to one of ordinary skill in the art to utilize a praseodymium sulfate as the anticorrosive pigment.

Double Patenting

12. Claims 1-7, 15, 17, 35, 42-45, 70, and 151 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 39-41 of copending Application No. 10/758,973 (published as US 2004/0186201, cited on IDS filed 3/16/2005).

US appl. '973 claims a coating composition comprising one or more rare earth oxide compounds, a binder, and one or more neutral to slightly acidic generating extenders. While US appl. '973 claims, in addition to the presently claimed ingredients, a corrosion-inhibiting carbon pigment, the scope of the instant claims clearly encompass the cited claims of US appl. '973 and thus is rendered obvious over US appl. '973.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Applicant's statement on page 18 of the amendment filed 4/19/2007 regarding the provisional obviousness-type double patenting rejections is acknowledged. If the following double-patenting rejection is the only rejection remaining in this application and if there is a provisional obviousness-type double patenting rejection in the later-filed copending application, per USPTO practice, the examiner will withdraw the rejection.

Response to Arguments

14. Applicant's arguments filed 4/19/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Takeuchi et al does not disclose an organic binder; (B) that Takeuchi et al does not disclose the combination of a binder and praseodymium oxide; (C) that Takeuchi et al does not disclose mixtures of inorganic bulking agents; (D) that Shoji does not disclose the use of 1-90 wt % praseodymium oxide; (E) that applicant's show superior results for compositions of rare earth compounds and calcium sulfate and/or strontium sulfate; and (F) that Shoji teaches away from a coating system with not reasonable expectation of success.

With respect to argument (A), Takeuchi et al discloses the use of binders such as polycarbosilane resin, polysilastyrene resin, and polysilazane resin, all of which are organic binders as defined by applicant on page 7, paragraph 0021, which states that "[o]rganic binders are made up of organic monomers and oligomer". Specifically, non carbon backbone organic binders are disclosed such as siloxanes and silicate polymers (and even claimed, see instant claim 19).

With respect to argument (B), the MPEP states that a reference that clearly names a claimed species anticipates that species no matter how many additional species are named (MPEP § 2131.02). Therefore, given that Takeuchi et al provides a list of ingredients including Pr_6O_{11} , Pr_6O_{11} is anticipated.

With respect to argument (C), Takeuchi et al discloses mixtures of inorganic additives. Regardless, it is well settled that it is *prima facie* obvious to combine two ingredients, each of

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which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972).

With respect to argument (D), Shoji discloses that oxides of rare earth compounds (col. 9, lines 50-53) and teaches that rare earth compounds include praseodymium (col. 7, lines 40-43). Shoji further provides guidance to determine suitable amounts of the additives (col. 9, lines 55-63 and col. 14, lines 53-62) and therefore makes the amounts a result effective variable. Case law holds that “discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.” See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

With respect to argument (E), the data has been considered but it not a proper comparison to the closest prior art. Specifically, all of the data in Table 3 appears to have a positive “2000 HRS Salt Fog Rating.” To be a proper comparison to the closest prior art, it should be shown that not all extenders, for instance kaolin, provide for desirable properties given that Reuter teaches a plurality of extenders. Furthermore, the data has to be reasonably commensurate in scope with the claimed invention. Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983).

With respect to argument (F), Shoji discloses an anti-corrosion coating composition containing the presently claimed ingredients. While Shoji includes other ingredients not encompassed by the presently claimed invention, such does not preclude a coating from being capable of being corrosion resistant. Furthermore, it is noted that the features upon which applicant relies (i.e., pH of 4 to 8) are not recited in the rejected claim(s). Although the claims

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are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/7/2007

Vickey Ronesi



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